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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,080	07/15/1999	MASSIMO BALESTRI	21197	4578

7590

04/09/2003

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EXAMINER

KLIMACH, PAULA W

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 04/09/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/354,080

Applicant(s)

BALESTRI ET AL

Examiner

Paula W Klimach

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 2131

Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
 - (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
 - (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
 - (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
 - (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
 - (f) BRIEF SUMMARY OF THE INVENTION.
 - (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
 - (h) DETAILED DESCRIPTION OF THE INVENTION.
 - (i) CLAIM OR CLAIMS (commencing on a separate sheet).
 - (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
 - (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).
2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the

Art Unit: 2131

embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

3. Claim 1 is objected to because of the following informalities: Line 12 should be “processing function (VM) capable of recognizing” instead of “capable recognizing”. Appropriate correction is required.

Line 14 should be “identifying code to enable” instead of “identifying code, to enable.”

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The components making up the system for controlled delivery of digital services by a plurality of providers to a plurality of users have not been listed in the claim.

Therefore, it is not clear what the system consists of. In order to further prosecute the case, the office assumes that the system consists of:

- at least one device for at least one service provider to transmit the encoded data stream

- at least one receiver for at least one user to receive the encoded transmission mentioned above

connected to each other by a network.

The above examples are illustrative only. Applicant is requested to ensure that any other instances are corrected.

Claim Rejections - 35 USC § 103

5. **Claim 1, 2, 3, 4, 6, 7, 8, 9, 10, 11, 13, and 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (5, 539, 823) in view of Spies (6, 055, 314).

In reference to claims 1 and 8, Martin discloses a system comprising at least one device for at least one service provider to transmit the encoded data stream and at least one receiver for at least one user to receive the encoded transmission. The transmitter disclosed by Martin sends an encoded data stream, claim 1 lines 7-12 and line 18. The receiver disclosed by Martin receives the encoded data and decodes it, column 11 lines 41-45.

However Martin does not disclose a system where an algorithm is incorporated into the data stream for enabling the use of the services.

Spies discloses a system where the algorithm for enabling the use of respective services is incorporated into a data stream, abstract. Spies also teaches of a key that is transmitted from the merchant computing unit, column 6 lines 21-

Art Unit: 2131

25. This key is the identifying code because it is used to identify the smart card to which the algorithm is to be downloaded and thus the purchaser.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the system described by Spies to incorporate the algorithm for enabling the use of the services into a data stream. One of ordinary skill in the art would have been motivated to do this because building a system that has no global secrets built into any hardware eliminates the risk of cracking the specific hardware component, Spies column 2 lines 0-5.

In reference to claims 2, 3, 9, and 10, the user unit is configured as a removable processing support in the Spies system, 50 in figure 9. The removable processing unit is a smart card, abstract. The smart card is associated with the purchaser (user), claim 44 lines 1-4, and arranged to selectively associate said reception means, column 3 lines 5-10.

In reference to claims 4, 6, 11, and 13, the system described by Spies discloses a program key that is download over the network, therefore in a data stream, onto the smart card to enable the viewing of the purchased video, column 16 lines 20-30 and Fig. 9.

In reference to claims 7 and 14, the system described by Spies can be activated by the user unit to transmit information about the confirmation of the purchase request, thus about the delivery of the service.

6. **Claims 4 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Spies as applied to claim 8 above, and further in view of Jones et al (5, 623, 637).

Martin and Spies do not expressly disclose a system with a trusted middleware function in the reception means and a trusted middleware function in the dynamic part.

Jones discloses an embodiment of a system where trusted software carries out an authentication algorithm on the IC card (smart card) as well as on the host, column 8 line 13-34.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have a trusted middleware function in the static part (the host in the Jones system) and have a middleware in that dynamic part (the smart card). One of ordinary skill in the art would have been motivated to do this because the removable card allows data stored on the card to be made immediately available to the connected host computer, Jones column 2 lines 23-29.

7. **Claims 5 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Spies as applied to claim 1 and 8 respectively above, and further in view of Waslewski (6,157,719).

Martin and Spies do not expressly disclose a system where the service providers emit data streams as MPEG data streams and receivers that extract the EMM messages, interpret the identifying code and execute the enabling algorithm on the basis of the identifying code.

Waslewski teaches of a system for conditional access where the service provider sends data streams in MPEG format, column 18, lines 32-35. The receiver extracts the EMM message from the data stream, column 5 lines 9-13,

Art Unit: 2131

where it stores the information from the EMM, therefore must extract the information. It uses a control word that includes authorization information from the EMM, therefore it interprets the identification code contained in the EMM message, column 4 lines 52-58. Waslewski teaches of an algorithm that generates the control word, which is used to decrypt the information, if the subscriber is entitled to watch the program, thus an enabling algorithm that is on the basis of the authentication information (identification code).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the Waslewski system for sending MPEG data streams from the service provide described by Martin. One of ordinary skill in the art would have been motivated to do this because service providers (service distribution organizations) provides its subscribers with information from a number of services, Waslewski column 4 lines 18-25.

8. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Spies as applied to claim 8 above, and further in view of Kaplan et al (6,141,339).

Martin and Spies do not teach the use of Java cards.

Kaplan teaches of Java cards used to receive applets from service nodes, column 5 lines 59-61. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Java cards for the user unit. One of ordinary skill in the art would have been motivated to do this because Java applets provide the intelligence to support features, Kaplan column 5 lines 61-65.

Conclusion

Art Unit: 2131

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Martin (5, 539, 823)

Spies (6, 055, 314)

Jones et al (5, 623, 637)

Waslewski (6,157,719)

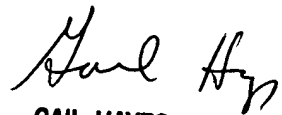
Kaplan et al (6,141,339)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (703) 305-8421. The examiner can normally be reached on Mon to Fri 7:15 a.m to 3:45 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on (703) 305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-8421 for regular communications and (703) 305-8421 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4832.

PWJ
April 1, 2003


GAIL HAYES
SUPERVISORY PATENT EXAMINER
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